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To: OIPE Scanning, CP2-5C21
From: Board of Patent Appeals
and Interferences (BPAI)

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Affirmed

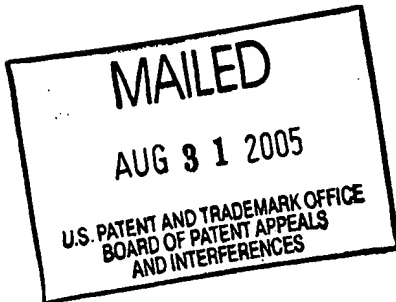
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte KENNETH W. NIMMONS

Appeal No. 2005-1258
Application No. 09/820,091

ON BRIEF

Before GARRIS, PAK, and JEFFREY T. SMITH, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 2 through 13, 15 through 18 and 32 through 56, which are all of the claims pending in the above-identified application.¹

¹ The appellant asserts that "[c]laim 6 is withdrawn from further consideration [by the examiner]." See the Brief, pages 2-3. However, both the final Office action (mailed November 24, 2003) and the Answer (mailed September 23, 2004) indicate that the examiner has considered the merits of claim 6 and rejected it. The appellant also "appeals to the Board of Appeals from the decision dated November 24, 2003, of the Examiner finally rejecting Claims 2-13, 15-18 and 32-56." See the Notice of Appeal dated April 26, 2004, page 1.

APPEALED SUBJECT MATTER

According to the appellant (the Brief, page 8):

Appellant considers the patentability of claims 2-4, 7-11, 13, 15-18, 32-40, 42, 43 and 45-55 stand or fall together. The patentability of claims 5, [6,] 12, 41, 44 and 56 stand or fall together.²

Therefore, for purposes of this appeal, we select claims 7 and 5 from all of the claims on appeal and determine the propriety of the examiner's Section 103 rejections set forth in the Answer based on these claims consistent with 37 CFR § 1.192(c)(7)(2003) and 37 CFR § 41.37(c)91)(vii)(2004). Claims 7, 2, and 5 are reproduced below³:

7. A base for use during the play of baseball or softball, comprising:

a bottom:

a top face;

a side wall attached to said bottom and said top face,

an identification label attached to said top face; and

wherein said top face comprises a cutout into which said identification label is inserted.

² The appellant has grouped the claims on appeal into two groups of claims in accordance with the two grounds of rejection set forth in the Answer. See the Brief, page 8. However, claim 6 has not been included in any of these groups set forth at page 8 of the Brief. Nor has the appellant separately argued the limitations recited in claim 6. See the Brief and the Reply Brief in their entirety. Thus, consistent with the appellant's request at page 3 of the Reply Brief, we determine that claim 6 stands or falls together with claims 5, 12, 41, 44 and 56, since they are subjected to the same ground of rejection set forth at page 7 of the Answer. *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002).

³ We have reproduced claim 2 as well in order to impart better understanding of the scope of claim 5. Claim 5 embodies the limitations of claims 2 and 7 since claim 5 is dependent on claim 2, which, in turn, is dependent on independent claim 7.

2. The base of claim 7, wherein said identification label comprises indicia.
5. The base of claim 2, wherein said identification label comprises: a photopolymer coating applied over a printed image of indicia.

PRIOR ART

The prior art references relied upon by the examiner in support of the Section 103 rejections before us are:

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|-------------------------------|--------------|---------------|
| Bartoli | 5,000,447 | Mar. 19, 1991 |
| Motooka et al. (Motooka) | 5,584,133 | Dec. 17, 1996 |
| Kennedy, III et al. (Kennedy) | 6,200,239 B1 | Mar. 13, 2001 |

Sports: The Complete Visual Reference, A Firefly Book, 2000, pages 220-221 (hereinafter referred to as "Sports").

REJECTION

Claims 2 through 4, 7 through 11, 13 through 18, 32 through 40, 42, 43 and 45 through 55 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Bartoli, Sports and Motooka. Claims 5, 6, 12, 41, 44 and 56 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Bartoli, Sports, Motooka and Kennedy.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the evidence and arguments advanced by both the examiner and the appellant in support of their respective positions. This review has led us to conclude that the examiner's Section 103 rejections are well founded. Accordingly, we affirm the examiner's Section

103 rejections for essentially the factual findings and conclusions set forth in Answer. We add the following primarily for emphasis and completeness.

The appellant has not disputed that Bartoli and Sports teach baseball bases having a bottom, a top surface and a side wall attached to the bottom and the top surface. Compare the Answer, pages 5 and 6, with the Brief and the Reply Brief in their entirety. Nor has the appellant challenged the examiner's official notice that "[p]roviding identification label(s) on sports paraphernalia [inclusive of baseball bases] is old and conventional."⁴ Compare the Answer, page 5, with the Brief and the Reply Brief in their entirety. Rather, the appellant argues that neither Bartoli nor Sports teaches or suggests forming a cutout (a recessed area) in either a top surface or a side wall of the baseball bases taught by Bartoli or Sports and inserting an identification label therein. See the Brief, page 9.

Thus, the dispositive question is whether it would have been obvious to provide a cutout area (a recessed area) in a top surface or sidewall surface of the baseball bases taught by Bartoli or Sports for the purpose of placing an identification label, such as logos, trademark, etc. therein. On this record, we answer this question in the affirmative.

As is apparent from the Brief and the Reply Brief, the appellant has not disputed the examiner's determination that both Motooka and Kennedy teach forming a cutout area

⁴ The appellant has acknowledged at page 5 of the specification that the baseball base described in Bartoli is sold "under the trademark Schutt Sports." Further, the appellant has not questioned the examiner's determination that Sports teaches a baseball base with an identification label. See the response dated September 15, 2002, the Brief and the Reply Brief in their entirety.

on a baseball glove or a basketball and placing therein an identification label. We find that both Motooka and Kennedy teach applying a transparent polymer over the identification label placed in the cutout area for protective purposes. See Motooka, column 3, lines 46-51 and Kennedy, column 4, lines 30-39.

Given the knowledge relating to conventional use of an identification label on sports paraphernalia or implements, including baseball bases, we determine that one of ordinary skill in the art would have been led to provide a polymer protective coating and an identification label in a cutout area of, inter alia, the top surface of the baseball base of the type described in Bartoli and/or Sports, motivated by a reasonable expectation of successfully obtaining the advantages associated with protecting the identification label.

The appellant argue that Motooka and Kennedy are from non-analogous art and thus are not combinable with Bartoli and Sports. See the Brief, pages 9-13 and the Reply Brief, pages 6 and 7. We do not agree.

As our reviewing court in In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) stated:

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

Whether prior art is analogous is a question of fact. See In re Paulsen, 30 F.3d 1475, 1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

As indicated supra, Motooka and Kennedy, like the appellant, not only teach employing an identification label to personalize or advertise sports paraphernalia or implements, but also teach improving the way in which an identification label is affixed to sports paraphernalia or implements. Specifically, Motooka and Kennedy, like the appellant, are directed to affixing an identification label in a more protective manner. Compare Motooka, column 3, lines 46-51 and Kennedy, column 4, lines 30–39, with the specification, page 4. In other words, the purposes of affixing an identification label disclosed by the inventor and the prior art, namely Motooka and Kennedy, are identical or substantially identical. It follows that Motooka and Kennedy are reasonably pertinent to the particular problem with which the inventor is involved. Thus, one of ordinary skill in the art interested in affixing identification labels to baseball bases, as taught by Bartoli and/or Sports, would look to Motooka and Kennedy to improve the way in which their identification labels are affixed.

The appellant appears to argue that one of ordinary skill in the art would have been led away from employing Motooka's name plate structure on Bartoli's bases because it "could lead to players tripping" and would render Bartoli's bases illegal for use during a regular baseball game. See the Brief, page 11. This argument, however, is not persuasive since it is speculative and is not supported by any objective evidence. In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Even were we to agree with the appellant's speculative assertion, our conclusion would not be changed. In the first place, as acknowledged by the appellant (the specification, page 1), it is well known to market baseball and softball by providing

merchandise that would be of interest to collectors of sports memorabilia. ... Significant interest has been generated by collectors to obtain game used items. Such items in this category would be baseballs, baseball bats, jerseys, hats, shoes, batting gloves, etc.

Thus, one of ordinary skill in the art would have been led to collect game used items, including baseball bases, for example, from different eras for display purposes and would not have been dissuaded from using Motooka's name plate to identify such baseball bases.⁵

CONCLUSION

Thus, based on the totality of record, including due consideration of the appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's decision rejecting all the claims on appeal under 35 U.S.C. § 103.

⁵ Kennedy also teaches affixing a medallion containing a logo (name plate) in a cutout (recessed) area without changing the contour of sports paraphernalia or implements. See Figures 5 and 6. Thus, for those baseball bases to be used in baseball games, one of ordinary skill in the art would have been led to affix an identification label in such a manner (the manner taught by Kennedy) as to maintain the desired contour of baseball bases, motivated by a desire to maintain the shape preferred by, e.g., Bartoli and avoid any violation of the rules of baseball game.

AFFIRMED

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